

REMARKS

Claims 1-61 were pending in this application.

Claims 22-30 have been withdrawn as being directed to a non-elected species.

Claims 1-9 and 31-61 have been rejected.

Claims 10-21 have been objected to.

Claims 1, 2, 10, 13, 14, 20, 21, 31, 32, 39, 44, 51, and 56 have been amended as shown above.

Claims 22-30 have been cancelled without prejudice or disclaimer.

Claims 62-68 have been added.

Claims 1-21 and 31-68 are now pending in this application.

Reconsideration and full allowance of Claims 1-21 and 31-68 are respectfully requested.

I. ALLOWABLE CLAIMS

The Applicants thank the Examiner for the indication that Claims 10-21 would be allowable if rewritten in independent form to incorporate the elements of their respective base claims and any intervening claims.

The Applicants have amended Claims 10-21 as shown above. The Applicants respectfully submit that these amendments place Claims 10-21 in condition for allowance. Accordingly, the Applicants respectfully request full allowance of Claims 10-21.

II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1 and 6-9 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,522,829 to Michalos (“*Michalos*”). The Office Action rejects Claims 1-5 and 31-61 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,328,747 to Nun (“*Nun*”). These rejections are respectfully traversed.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Michalos recites a remotely operable surgical cutting instrument. (*Abstract*). The cutting instrument includes a body with two angled portions and a blade mounted on the end of one of the portions. (*Col. 1, Lines 50-56*). The cutting instrument could also include a turning unit on which the blade is mounted, and the turning unit controls the orientation of the blade’s cutting edge. (*Col. 2, Lines 34-42*).

Nun recites a cataract removing device (CRD) for surgically removing a cataract from a patient’s eye. (*Abstract*). A cryomanipulator can selectively adhere to tissue (such as a lens in the patient’s eye), allowing the tissue to be manipulated. (*Col. 2, Line 51 – Col. 3, Line 3*). A drill blade 246 on a drilling unit 230 is used to cut, break, or disintegrate a cataract or other part

of the lens in the patient's eye. (*Col. 15, Lines 40-51*). Once the cataract is removed, an artificial lens may be placed in the patient's eye. (*Col. 16, Lines 7-8*).

The Office Action states that various elements recited in the claims are recitations of intended use. The Office Action also states that a recitation of intended use must result in a structural difference between the claimed invention and the prior art. The Office Action further states that the Applicants' claims recite irrelevant "functional limitations." In addition, the Office Action states that the invention recited in the Applicants' claims is "not limited for performing eye surgery" and "could be used to cut any type of body tissue." (*Office Action, Page 5, Last paragraph – Page 6, Last paragraph*).

First, the Applicants respectfully note that every independent claim recites that a "surgical blade" is operable to be rotated through "scleral tissue of an eye" to make an "incision" forming a "scleral pocket" for receiving a "scleral prosthesis." Therefore, all pending claims are limited to making incisions in "scleral tissue of an eye."

Second, there is no support for the Office Action's assertion that the alleged "recitations of intended use" in the claims fail to result in a structural difference between the claimed invention and the prior art. *Michalos* and *Nun* cannot be used to make an "incision" in "scleral tissue of an eye" having the form of a "scleral pocket" for receiving a "scleral prosthesis" as recited in the claims.

Michalos and *Nun* both fail to disclose any way in which their devices could be used to make an "incision" in "scleral tissue of an eye." *Michalos* expressly recites that its surgical cutting instrument is inserted through a prior incision in the sclera. (*Col. 7, Lines 50-57*). *Nun*

expressly recites that its instruments are inserted into the eye through prior incisions in the cornea or the sclero-corneal region. (*Col. 15, Lines 4-24*).

Michalos and *Nun* both require their instruments to be inserted through prior incisions in the sclera, cornea, or sclero-corneal region. Both *Michalos* and *Nun* fail to disclose the use of their instruments to actually make incisions in the sclera. Since *Michalos* and *Nun* both require a surgeon to make incisions in the sclera, cornea, or sclero-corneal region before the instruments of *Michalos* and *Nun* are used, the Patent Office cannot simply assume that the instruments of *Michalos* and *Nun* are capable of making an “incision” in “scleral tissue of an eye.”

Even assuming that the instruments of *Michalos* and *Nun* could make incisions in scleral tissue of an eye, the instruments in *Michalos* and *Nun* are incapable of making an “incision” having the form of a “scleral pocket” for receiving a “scleral prosthesis” as recited in the claims. The instruments in both *Michalos* and *Nun* function basically like drills, where a blade is rotated circularly and is used to cut through or break up tissue. The Office Action provides no explanation as to how either instrument could be used to make an incision having the form of a “scleral pocket” for receiving a “scleral prosthesis.” At most, the instruments in *Michalos* and *Nun* could be used to drill through tissue in the eye, but the resulting cut would not have the form of a “scleral pocket” for receiving a “scleral prosthesis.” Again, the Patent Office cannot simply assume that the instruments of *Michalos* and *Nun* are capable of making an “incision” having the form of a “scleral pocket” for receiving a “scleral prosthesis” simply because both instruments use a blade.

For these reasons, *Michalos* fails to anticipate all elements of Claim 1 (and its dependent claims). Also, for these reasons, *Nun* fails to anticipate all elements of Claims 1, 31, 44, and 56 (and their dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 102 rejections and full allowance of Claims 1-9 and 31-61.

III. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Nun* in view of U.S. Patent No. 5,492,528 to Anis ("*Anis*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443,

1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (MPEP § 2142).

Claim 3 depends from Claim 1. As shown above, Claim 1 is patentable. As a result, Claim 3 is patentable due to its dependence from an allowable base claim.

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claim 3.

IV. NEW CLAIMS

The Applicants have added new Claims 62-68. The Applicants respectfully submit that no new matter has been added. At a minimum, the Applicants respectfully submit that Claims 62-68 are patentable for the reasons discussed above. The Applicants respectfully request entry

and full allowance of Claims 62-68.

V. **CONCLUSION**

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request full allowance of the claims.

SUMMARY


If any outstanding issues remain, or if the Examiner has any further suggestions for expediting prosecution of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicant has included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any additional extension of time fee) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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